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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,537	07/28/2003	Donald L. Groeschner	03141-P0451A	3582
24126	7590	09/09/2004		EXAMINER
ST. ONGE STEWARD JOHNSTON & REENS, LLC				PRUCHNIC, STANLEY J
986 BEDFORD STREET			ART UNIT	PAPER NUMBER
STAMFORD, CT 06905-5619			2859	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/628,537	GROESCHNER, DONALD L. 
	Examiner	Art Unit
	Stanley J. Pruchnic, Jr.	2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-20 and 26-31 is/are allowed.
- 6) Claim(s) 21 and 23-25 is/are rejected.
- 7) Claim(s) 22 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claim 21** is FINALLY rejected under 35 U.S.C. 102(b) as being anticipated by Progelhof *et al.* (U.S. Patent No. 3,605,494, hereinafter **PROGELHOF**).

Regarding Claim 21: PROGELHOF discloses a holder for materials for use in a measuring instrument, as claimed by Applicant, said holder comprising:

a three-piece housing consisting of an upper housing member (P), an intermediate housing member (G) and a lower housing member (C), the three-piece housing defining a first closed cavity and a second closed cavity (See the Figure);

a first winding assembly (coil or winding W1) disposed within the first closed cavity; and

a second winding assembly (coil or winding W2) disposed within the second closed cavity.

With respect to the intended use of the apparatus, *i.e.*, to hold materials for use in a measuring instrument: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Furthermore, the intended use is recited in the preamble. The functional limitations recited in the preamble have not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the

introductory clause. See *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In this instance, the description in the body of the claim does not draw life and meaning from the functional limitations in the preamble, since the functional limitations in the preamble do not have structural implications. Moreover, the winding assemblies, broadly considered, are "materials".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 and 23-25 are FINALLY rejected under 35 U.S.C. 103(a) as being unpatentable over **THOMANN** (U.S. Patent No. 4,178,800) in view of **O'NEILL** (U.S. Patent No. 5,098,196).

Regarding Claim 21 and 24: THOMANN discloses a holder (Fig. 1) for materials for use in a measuring instrument, as claimed by Applicant, said holder comprising:

a three-piece housing consisting of

- an upper housing member (the lid capping off the measuring zone 2; Fig. 1; Col. 2, Lines 52-65),
- an intermediate housing member (vessel 1); and
- a lower housing member (housing 4),

the three-piece housing defining a first closed cavity (measuring zone 2) and a second closed cavity (space 6).

THOMANN does not disclose a first winding assembly disposed within the first closed cavity; and a second winding assembly disposed within the second closed cavity as claimed by Applicant in Claim 21. **Further regarding Claim 24:** **THOMANN** does not disclose one of the first winding or the second winding comprises a heating winding and the other of the first winding or the second winding comprises a heat-sensing winding. However, **THOMANN** discloses, a heat source 7 disposed within the first closed cavity 2 of the vessel 1 (see Col. 2, Line 66 - Col. 3, Line 5); and heat sensors (e.g., heat sensors 11, 12, 13) disposed within the second closed cavity 6.

O'NEILL discloses that is known in the art to provide a resistance element in the form of a winding (or coil) for a heating winding and to provide a resistance element in the form of a winding (or coil) for a heat sensor for sensing a temperature of a wall of a sample container in order to control the heating of the container (Col. 1, Lines 47-54).

O'NEILL is evidence that ordinary workers in the field of calorimetry would have recognized the benefit of providing a winding for a heating device disclosed by **THOMANN** in order to heat the sample material and that ordinary workers in the field of calorimetry would have recognized the benefit of providing a winding for a heat sensor disclosed by **THOMANN** in order to sense the sample material temperature.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a winding for the heating device disclosed by **THOMANN** disposed within the first closed cavity 2 and to substitute a winding for the heat sensors disclosed by **THOMANN** disposed within the second closed cavity 6 as taught by **O'NEILL**.

Further regarding Claim 23: THOMANN further discloses vessel 1 is made of a material of good thermal conducting properties, e.g. copper and the housing 4 is a good conductor, preferably a metal (Col. 2, Lines 54-58). THOMANN does not disclose the materials of the housing members as claimed by Applicant in Claim 23. Regarding the materials of the housing members: the limitations in these claims, absent any criticality, are only considered to be the "optimum" materials of the housing members disclosed by THOMANN as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the housing members' materials of THOMANN as long as they have good thermal conducting properties, as taught by THOMANN.

Further regarding Claim 25: THOMANN further discloses heat-conducting element 10 (Fig. 1), which is a "center post". THOMANN does not disclose a washer member attached to the lower housing member. OFFICIAL NOTICE is taken with regard to the washer member attached to the lower housing member, since it is very commonly known to use washers whenever fastening metal components using bolts and nuts, in order to tightly fasten separate components. Therefore it would have been obvious for one of ordinary skill in the art to attach a washer member to the lower housing member in order to tightly fasten separate components. Moreover, THOMAN teaches the volume 6 is a vacuum. It is very common to use compressible washers

when assembling together the components of a vacuum chamber in order to make air-tight fittings. Therefore it would have been obvious to use a washer on the lower housing member in order to make a tight vacuum seal, as is well known in the art.

Response to Arguments

5. Applicant's arguments, see Response, filed 6 July 2004, with respect to the rejection(s) of claim(s) 21 and 23-25 under 35 USC 102(b) have been fully considered and are persuasive in view of the amendment. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly cited prior art.

Applicant's arguments with respect to claims 21 and 23-25 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments, see Response, filed 6 July 2004, with respect to Claim 13 have been fully considered and are persuasive. The rejection of **Claim 13** has been withdrawn. Moreover, NOREM discloses only one wall 60 (inadvertently labeled "62" in the previous Office Action, as correctly pointed out by Applicant). As NOREM's disclosure was interpreted in the Action, the wall 60 was considered part of an upper housing member as well as a lower housing member. Thus interpreted, the upper housing member cannot fairly be considered as "being seated within the upper recess of the intermediate housing member" as claimed by Applicant. Similar argument applies for the lower housing member. The "intermediate housing member" of NOREM (comprising member 92) does not provide any structure within which either the upper or lower housing members can be "seated within".

Allowable Subject Matter

7. Claims 1-20 and 26-31 allowed.
8. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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9. The following is a statement of reasons for the indication of allowable subject matter:

- a. **Claims 1 and 26** are allowable for the reasons already stated in the Office Action mailed 9 June 2004 in Paragraph 11 (Page 8).
- b. **Claim 22** would be allowable and newly presented **Claim 31** is allowable for the reasons already stated in the Office Action mailed 9 June 2004 in Paragraph 11 (Page 8), regarding Claims 16 and "21" (*sic*; intended to refer to -- 22--).
- c. **Claim 13** is allowable for the reasons stated above in Paragraph 2.

Claims 2-12, 14-20 and 27-30 are allowable by virtue of their dependence on the respective of allowed claims 1, 13 and 26.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the form PTO-892 and not mentioned above disclose related temperature measurement and calorimetric devices and methods.

US 5295745 A (Cassettari, Mario et al.) discloses related chambers in a calorimeter including use of electrically conductive windings for both heating and temperature measurement.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stanley J. Pruchnic, Jr., whose telephone number is **(571) 272-2248**. The examiner can normally be reached on weekdays (Monday through Friday) from 7:30 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. F. Gutierrez can be reached at **(571) 272-2245**.

The **Official FAX** number for Technology Center 2800 is **(703) 872-9306** for **all official communications**.

Any inquiry of a general nature or relating to the status of this application or proceeding may be directed to the official USPTO website at <http://www.uspto.gov> or you may call the **USPTO Call Center at 800-786-9199** or 703-308-4357. The Technology Center 2800 Customer Service FAX phone number is (703) 872-9317.

The cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

Private PAIR provides external customers Internet-based access to patent application status and history information as well as the ability to view the scanned images of each customer's own application file folder(s).

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9/7/04